

REMARKS

I. STATUS OF CLAIMS

Following entry of the amendment, claims 362-368 are pending in this application. Claims 362-368 are amended to include the recitations of claim 355-361, which are cancelled without prejudice or disclaimer. The specification and claims provide written description support for these claim amendments. Accordingly, no new matter is added by the amendments added herein, and their entry is respectfully requested.

II. REJECTIONS UNDER 35 U.S.C. § 112

A. Rejection under 35 U.S.C. § 112, first paragraph

Claims 355-361 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Office Action at pp. 3-9. The Examiner asserts that “[t]here is no support in the specification for claims drawn to the species belonging to structuring polymer, which is **“ethylenediamine/stearyl dimer tallate copolymer”**”. *Id.* at p. 3.

Applicants disagree with the Examiner’s assertions and maintain that one of ordinary skill would have known that ethylenediamine/stearyl dimer tallate copolymer was known by the trade name Uniclear®, as set forth in the specification, at the time the application was filed.

According to the International Cosmetic Ingredient Dictionary and Handbook, page 606, 9th ed. (2002), submitted with the Reply to Office Communication on April 28, 2008, ethylenediamine/stearyl dimer tallate copolymer, which has the tradename Uniclear, is a copolymer of ethylenediamine and tall oil dimer acid

monomers end blocked with stearyl alcohol. Applicants submit that written description for this copolymer can be found in the original specification at least at page 12, lines 14-25, which states that:

Non-limiting examples of at least one polyamide polymer may be used in the composition according to the present invention include commercial products sold by Arizona Chemical under the names Uniclear 80 and Uniclear 100. These are sold, respectively, in the form of an 80% (in terms of active material) gel in a mineral oil and a 100% (in terms of active material) gel. These polymers have a softening point from 88 to 94°C, and may be mixtures of copolymers derived from monomers of (i) C₃₆ diacids and (ii) ethylene diamine, and have a weight-average molecular mass of about 6000. Terminal ester groups result from the esterification of the remaining acid end groups and at least one alcohol chosen from cetyl alcohol and stearyl alcohol. A mixture of cetyl and stearyl alcohols is sometimes called cetylstearyl alcohol.

(emphasis added).

As the Examiner points out on pages 3-4 of the Office Action, the above description in the specification teaches species that can be formed from:

(i) C36 diacids and ethylenediamine and the terminal ester groups result from esterification of the remaining acid end groups can be with cetyl alcohol or the species can be formed from (ii) C36 diacids and ethylene diamine and the terminal ester groups result from esterification of the remaining acid **end groups can be with stearyl alcohol or** the species can be formed from [(iii)] C36 diacids and ethylenediamine and the terminal ester groups result from esterification of the remaining acid end groups can be with a mixture of cetyl and **stearyl alcohols** also known as cetylstearyl alcohol.

(emphasis added). This description readily conveys a copolymer of ethylenediamine and tall oil dimer acid monomers end blocked with stearyl alcohol such as the ethylenediamine/stearyl dimer tallate copolymer recited in claims 362-368.

In addition, Applicants submit that the evidence already of record, for example the Cosmetic Toiletry and Fragrance Association's December 14, 1999, letter and Dr. Lochhead's Expert Report submitted with the Amendment and Reply Office Action ("Amendment") filed February 5, 2009, establishes that the ethylenediamine/stearyl dimer tallate copolymer was known by those of ordinary skill as Uniclear[®] at the time of filing of the present application.

On pages 8-9 of the Office Action, the Examiner recognizes that paragraph 14 of Dr. Lochhead's Expert Report "suggests that as of December 1999 that the trade name UNICLEAR was associated with the tallate copolymer." However, the Examiner asserts that "this does not establish that the same was true as of applicant's filing date." Office Action at p. 6. Applicants respectfully disagree. If the trade name Uniclear was associated with the tallate copolymer as of December 1999, then the tallate copolymer was known by those of ordinary skill as Uniclear[®] at the time of filing of the present application, December 12, 2000.

Moreover, a trademarked product may cover a range of products containing the same copolymer family, but having different concentrations, in different solvents or with different additives, leading to different physicochemical properties. As mentioned in the specification, Uniclear 80 and Uniclear 100 have different formulations. For example, Uniclear 80 and Uniclear 100 contain different concentrations of active material. Such difference in concentrations may explain the different softening points discussed by the Examiner at page 7 of the Office Action.

In summary, the specification describes the copolymers known as Uniclear[®] and demonstrates that Uniclear[®] is the trade name for ethylenediamine/stearyl dimer tallate

copolymer. Moreover, the CFTA's December 14, 1999, letter and Dr. Lochhead's Expert Report, which relies upon the CFTA's letter, submitted with the Amendment filed on February 5, 2009, is further evidence that the ethylenediamine/stearyl dimer tallate copolymer was known by those of ordinary skill as Uniclear[®] at the time of filing of the present application. Accordingly, Applicants submit that claims 362-368 (which include the subject matter of claims 355-361) are fully supported by the specification as filed.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

B. Rejection under 35 U.S.C. § 112, second paragraph -- Claims 356, 358, 361, 363, 365, and 368

Claims 356, 358, 361, 363, 365 and 368 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Office Action at p. 2.

First, the Examiner asserts that claims 356, 358, 361, 365 and 368 lack antecedent basis with respect to the recitation "said composition" because the claims recite a "cosmetic composition," not merely a composition. *Id.* Applicants respectfully disagree with the Examiner's assertion. However, to advance prosecution, Applicants amended claims 363, 365, and 368 to recite "said cosmetic composition," instead of "said composition." Claims 356, 358, and 361 are cancelled. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

In addition, the Examiner asserts that claims 358 and 365, which recite "a method comprising applying a cosmetic composition," are ambiguous and lack clarity. Office Action at p. 2. Applicants respectfully disagree with the Examiner's assertion. The method recited in claim 365 includes one step, "applying a cosmetic composition to

a keratin material.” In addition, claim 365 defines the cosmetic composition. Accordingly, it is unclear what is ambiguous or lacks clarity in this claim. Thus, Applicants respectfully request that the Examiner withdraw the rejection. If, however, the Examiner maintains the rejection, Applicants request that the Examiner to clarify her position regarding why the method recited in claim 365 is ambiguous.

C. Rejection under 35 U.S.C. § 112, second paragraph -- Claims 355-368

Claims 355-368 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Office Action at p. 9. The Examiner asserts there is only one copolymer recited in claims 355-368. Thus, the recitations “at least one” and “chosen from” lack clarity and render the claim unclear. *Id.*

Applicants disagree with the Examiner’s rejection for the reasons set forth in the Amendment filed February 5, 2009. However, to advance prosecution Applicants amended claims 362-368 to recite “at least one structuring polymer chosen from ethylenediamine/stearyl dimer dilinoleate copolymer and ethylenediamine/stearyl dimer tallate copolymer,” and cancelled claims 355-361. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

III. REJECTION UNDER 35 U.S.C. §103

Claims 355-368 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of U.S. Patent No. 5,783,657 to Pavlin et al. ("Pavlin") and U.S. Patent No. 6,423,324 to Murphy et al. ("Murphy"). Office Action at p. 11.

The cosmetic composition recited in amended claims 362-368 (which include the subject matter of claims 355-361) comprise a structuring polymer chosen from ethylenediamine/stearyl dimer dilinoleate copolymer and ethylenediamine/stearyl dimer tallate copolymer. Pavlin, on the other hand, only teaches a composition comprising a polyamide of formula (I), encompassing thousands, if not millions, of possible structuring polymers to try.

"The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness." M.P.E.P. §2144.08 (citing *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not render the compound obvious.")). While Pavlin discloses an ester-terminated polyamide (ETPA) of formula (I), there is no disclosure of the claimed species of structuring polymers, e.g., Uniclear, recited in claims 362-368. Moreover, there is no teaching or suggestion in Pavlin that would direct one of ordinary skill in the art to choose Uniclear rather than one of the other structuring polymers encompassed by formula (I). In fact, Pavlin would direct one of ordinary skill in the art away from Uniclear.

Uniclear is derived from the condensation polymerization of: about 76.62 wt% of a dimer acid (Empol 1011), about 5.87 wt% of an amine (ethylene diamine), and about 17.51 wt% of an alcohol (Alfol-18, i.e., stearyl alcohol).¹ See Information Relevant to the Use and Availability of UNICLEAR 80/100, attached herewith as Exhibit 1. From a review of Pavlin, the closest ester-terminated polyamide (ETPA) to Uniclear is Example 8. See Pavlin, col. 20, line 55 to col. 21, line 14. Example 8 is an ETPA derived from 76.4 wt% of the dimer acid Empol 1008, 5.9 wt% of ethylene diamine, and 19.7 wt% of stearyl alcohol. See *id.* Example 8, however, reports that gels formed from this Uniclear-like structurant made from 19.7 wt% stearyl alcohol were opaque, not clear. See *id.* at col. 21, lines 12-14. Further, Example 8 warns that “[t]his example shows that there is a lower limit to the alcohol concentration that can be used in an ETPA, and still obtain a transparent gel therefrom.” See *id.* at col. 20, lines 60-62. In view of the fact that Uniclear is an ETPA that is derived from only about 17.51 wt% stearyl alcohol, it is below the lower limit taught by Pavlin for making clear gels. Accordingly, a person of ordinary skill in the art would have been directed away from using Uniclear as the structuring polymer by this disclosure in Pavlin.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02(VI). Indeed, the totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is “strong evidence of unobviousness.” *In re Hedges*, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986). When the disclosure of

¹ Alfol-18 is a tradename for stearyl alcohol. See International Cosmetic Ingredient Dictionary and Handbook 1654 (9th ed. 2002), submitted herewith as Exhibit 2.

Pavlin is considered in its entirety, as required, see M.P.E.P. § 2141.02(VI), a person would have been directed away from Uniclear by Pavlin teaching that a stearyl alcohol concentration of 19.7 wt% or below in an ETPA would form an undesirable opaque gel. This teaching away in Pavlin would have led one of ordinary skill in the art to other disclosed ETPA structuring polymers with a stearyl alcohol concentration of greater than 19.7 wt%. Thus, common sense would dictate against both selection and addition of Uniclear from among the other ETPA structuring polymer disclosed in Pavlin

Murphy does not rectify the deficiencies of Pavlin discussed above. Thus, Applicants submit that the Examiner failed to establish a *prima facie* case of obviousness over Pavlin and Murphy. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the foregoing rejection.

IV. COMMONLY ASSIGNED CO-PENDING APPLICATIONS AND PATENTS

In previous submissions, Applicants noted information regarding co-pending applications and patents, and submitted copies of the pending claims as of the date of those submissions for every case identified. Applicants submit herewith, as Exhibit 3, a copy of the pending and/or issued claims of Application Nos. 09/733,899, and 09/749,036, which have been amended or issued since February 5, 2009. Applicants submit those claims for the Office's convenience in evaluating any potential issues regarding statutory or obviousness-type double patenting.

V. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: October 1, 2009

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Attachments:

Exhibit 1 - Information Relevant to the Use and Availability of
UNICLEAR 80/100;

Exhibit 2 - International Cosmetic Ingredient Dictionary
and Handbook ("CTFA") 9th ed., p. 1654 (2002).

Exhibit 3 - Copies of Claims from Two (2) Copending Applications.